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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,082	01/08/2004	Holger Hoppe	543822003200	5415
25227	7590	09/22/2004	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			CHAN, EMILY Y	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/753,082	HOPPE, HOLGER	
	Examiner	Art Unit	
	Emily Y Chan	2829	<i>Am</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/8/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/8/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-6, 8-9 and 11-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 13-15 of copending Application No. 10/753075. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1, 11 and 14 of the instant application and the claims 1, 9, 11, 13 and 15 of co-pending application (10/735075) are directed to the same socket or adapter device and the same method for testing semiconductor devices. The claimed components associated with functions recited in the claims 1, and 11 of the instant application such as "a socket or adaptor", "at least one connection pin"; "a contact device" are all recited in the claims 1, 9, 11 and 13 of the co-pending application (10/735075). The components and steps recited in the method claim 15 of the instant application are all recited in the method claim 14 of the co-pending application (10/735075). Therefore, the instant application encompasses the

scope of the co-pending application (10/735075). Claims 2-5 of the instant application are identical to the claims 2-5 of the co-pending application (10/735075). Claim 6 of the instant application recites that the one section of pin has a curved shape, which encompasses the bent shape as claimed in claim 6 of the co-pending application (10/735075). Claims 8-9 of the instant application are identical to the claims 7-8 of the co-pending application (10/735075). Claims 12-13 of the instant application are identical to the claims 10 and 14 of the co-pending application (10/735075).

2. Claims 7 and 10 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-11 and 13-14 of copending Application No. (10/735075) in view of Ono et al ("106).

3. Claims 1-11 and 13-14 of copending Application No. (10/735075) do not recite that the section of the connection pin has the shape of a wave attenuated in a direction leading away from the socket or adapter device for claim 7 and the contact device comprises a recess or a bore into which the connection is introduced for claim 10 of the instant application.

4. Regarding to claim 7 of the instant application, Ono et al ("106) disclose a pin contact of a connector (see Fig. 1) and exclusively teach that a section of the connection pin (2) comprises a curved portion 4 and linear portion 7 and is to fit into a spring portion of a socket contact (1). Therefore, Ono et al ("106)'s connection pin meets the claimed connection pin because when Ono et al ("106)'s connection pin is inserted into the contact spring portion of the socket contact, it should be formed in the shape of wave attenuated in direction into the socket contact (1).

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5. Regarding to claim 10 of the instant application, Ono et al ("106) disclose a contact device (socket contact 1) comprises a recess or a bore (projection portion 9) which the connection pin (2) is introduced (see Fig.2).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate the connection pin and the contact device with recess (projection portion) as taught by Ono et al ("106) into the socket or adapter of the co-pending application (10/735075) for the expected benefit of providing a contact structure which is easy to insert into the contact device as disclosed by Ono et al ("106) (see Col. 3, lines 29-33).

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chung ('803) discloses a test socket comprising a connection pin and contact device as claimed.

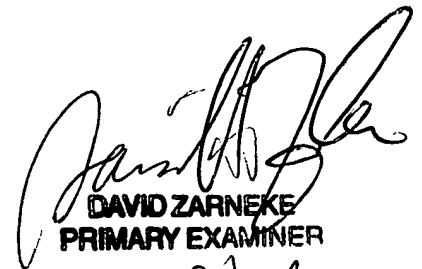
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Y Chan whose telephone number is 571-272-1956. The examiner can normally be reached on 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 571-272-1812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ec
9-16-04


DAVID ZARNEKE
PRIMARY EXAMINER
